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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/447,077	11/22/1999	DANA C. BOOKBINDER	16-6-1	3342
22928	7590	03/02/2004	EXAMINER	
CORNING INCORPORATED			MARKHAM, WESLEY D	
SP-TI-3-1			ART UNIT	
CORNING, NY 14831			PAPER NUMBER	
			1762	

DATE MAILED: 03/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/447,077

Applicant(s)

BOOKBINDER ET AL. 

Examiner

Wesley D Markham

Art Unit

1762

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 23 January 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached Office Action.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 1,2,4,10-12,14,16-21,28,32,33,50-52 and 58.

Claim(s) objected to: _____.

Claim(s) rejected: 53.Claim(s) withdrawn from consideration: 34-49.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____.

DETAILED ACTION / ADVISORY ACTION

Response to Request for Reconsideration

1. Acknowledgement is made of the "Response to the Examiner's Office Action" filed by the applicant on 1/23/2004. The applicant is thanked for providing a complete **Listing of the Claims** in the aforementioned response, even though no changes and/or amendments to the claims were made. The examiner notes that the status identifier used for Claim 1 (i.e., "Previously Amended") is not one of the status identifiers permitted by the Office, and the applicant is suggested to use the "previously presented" status identifier in future communications. Claims 1, 2, 4, 10 – 12, 14, 16 – 21, 28, 32 – 53, and 58 are currently pending in U.S. Application Serial No. 09/447,077 (with claims 34 – 49 being withdrawn without traverse from consideration by the examiner pursuant to a restriction requirement), and an Advisory Action follows.

Terminal Disclaimer

2. The terminal disclaimer filed on 8/21/2003 (with a certificate of mailing dated 8/19/2003) disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of any patent granted on Application Number 09/569,562 has been reviewed by the appropriate paralegal and is accepted. The terminal disclaimer has been recorded.

Specification

3. The applicant's concurrence with the examiner's interpretation of "(silica-containing) article used in the manufacture of an optical fiber" (see paragraph 3 of the previous Office Action (i.e., the final Office Action, mailed on 12/1/2003) and section 3 of the applicant's response filed on 1/23/2004) is noted.

Response to Arguments

4. Applicant's arguments filed on 1/23/2004 have been fully considered but they are not persuasive.
5. Regarding the 35 U.S.C. 103(a) rejection of Claim 53 as being unpatentable over Tsuji et al. (JP 02-258643 A) in view of either Gosset et al. (USPN 4,632,848) or Yamashita et al. (USPN 6,211,282 B1), the applicant makes the following arguments, each of which will be addressed in turn.
6. Broadly, the applicant argues that none of the cited references, alone or in combination, teach or suggest applying a protective layer consisting essentially of an alkyl ammonium compound, and aryl ammonium compound, or a wax to a consolidated glass surface of an article used in optical fiber manufacture. More specifically, the applicant states that Tsuji et al. teaches a class of coatings which are meant to be easily peelable and are polymer coatings. The applicant then argues that, even though the term "etc." is used by Tsuji et al., only polymeric coatings would be included in the class of coatings taught by Tsuji et al., and as such, there would be no motivation to select the wax coatings taught by Gosset et al.

Art Unit: 1762

or Yamashita et al. for an article used in optical fiber manufacture. In response, the applicant's argument is not convincing. The examiner notes that the specific examples of coatings taught by Tsuji et al. all appear to be "resin" coatings. However, nothing in Tsuji et al. teaches or suggests that other types of protective coatings (e.g., wax coatings) would not be operable. On the contrary, the exact chemical nature or composition of the coatings of Tsuji et al. does not appear to be critical, as evidenced by the numerous different coatings taught by Tsuji et al. (see page 5, paragraph 2). The overall goal / objective of Tsuji et al. is to provide an optical fiber perform to which the adhesion of dust and dirt is prevented during processing (see page 2, "Industrial Application Field", and page 4, paragraph 1). As such, one of ordinary skill in the art would have been motivated to apply a protective layer that consists essentially of a wax (as taught by either Gosset et al. or Yamashita et al.) to the optical fiber preform of Tsuji et al. instead of the protective resin layer taught by Tsuji et al. with the reasonable expectation of success and obtaining similar results (i.e., successfully protecting the glass preform from dust, dirt and/or mechanical damage by using a temporary protective coating, regardless of whether the coating consists essentially of a wax or is made of a polymer / resin). In other words, one of ordinary skill in the art would have reasonably expected to achieve the overall goal (i.e., protection) of Tsuji et al., regardless of the nature of the protective coating.

7. Second, the applicant argues that a person of ordinary skill in the art would not be motivated to select the prior art waxes taught by Gossett et al. or Yamashita et al.

Art Unit: 1762

because neither of these waxes are easily peelable, which is a property desired by Tsuji et al. In other words, the applicant argues that, if the class of coatings taught by Tsuji et al. were substituted with the wax coatings of the prior art, the overall function of being "easily peelable" taught in Tsuji et al. would be destroyed. In response, the applicant's argument is not convincing. The examiner disagrees with the applicant's interpretation that the "overall function" of the coatings of Tsuji et al. is to be "easily peelable". The overall goal / objective of Tsuji et al., and thus the "overall function" of the coatings in Tsuji et al., is to provide an optical fiber perform to which the adhesion of dust and dirt is prevented during processing (see page 2, "Industrial Application Field", and page 4, paragraph 1). The easily peelable coatings taught by Tsuji et al. clearly represent one way to achieve this goal. However, the examiner maintains that protective wax coatings such as those taught by Gossett et al. or Yamashita et al. would be reasonably expected by one of ordinary skill in the art to achieve the overall goal of Tsuji et al. (i.e., temporary protection) as well. Therefore, the overall function of Tsuji et al. would not be destroyed by combining Tsuji et al. with either Gossett et al. or Yamashita et al. in the manner done so by the examiner. Additionally, the examiner notes that no evidence or disclosure has been provided by the applicant showing that the applicant's claimed coating, specifically a coating consisting essentially of a wax, does not suffer from the same disadvantages as the wax coatings taught by the prior art.

8. Third, the applicant argues that there is no motivation that the Tsuji et al. reference is in need of improvement because the Tsuji et al. polymer coating method works

Art Unit: 1762

adequately (i.e., is easily peelable), and therefore there is no motivation to select either Gosset et al. or Yamashita et al. in the first place. In response, the examiner has not stated or argued that the polymer coatings explicitly taught by Tsuji et al. do not work adequately. However, even though the coatings explicitly taught by Tsuji et al. may work adequately, one of ordinary skill in the art would still have been motivated to apply a protective layer that consists essentially of a wax (as taught by either Gosset et al. or Yamashita et al.) to the optical fiber preform of Tsuji et al. instead of the protective resin layer taught by Tsuji et al. with the reasonable expectation of success and obtaining similar results (i.e., successfully protecting the glass preform from dust, dirt and/or mechanical damage by using a temporary protective coating, regardless of whether the coating consists essentially of a wax or is made of a polymer / resin). In other words, one of ordinary skill in the art would have reasonably expected to achieve the overall goal (i.e., temporary protection) of Tsuji et al., regardless of the nature of the protective coating. The fact that the polymer protective coatings of Tsuji et al. work adequately would not have discouraged one of ordinary skill in the art from combining the references in the manner done so by the examiner.

9. Fourth, the applicant argues that the Gosset et al. patent teaches improvements to the prior art waxes relied upon by the examiner, thereby teaching away from the use of these prior art waxes. In response, the examiner notes that the teachings of a reference are not limited to its preferred embodiments. While the prior art waxes taught by Gosset et al. do have some disadvantages, nothing in Gosset et al.

Art Unit: 1762

suggests that the prior art waxes would not be operable to protect the optical fiber preform of Tsuji et al. Additionally, the examiner notes that no evidence or disclosure has been provided by the applicant showing that the applicant's claimed coating, specifically a coating consisting essentially of a wax, does not suffer from the same disadvantages as the wax coatings taught by the prior art, specifically Gosset et al.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wesley D Markham whose telephone number is (571) 272-1422. The examiner can normally be reached on Monday - Friday, 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive Beck can be reached on (571) 272-1415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Wesley D Markham

Application/Control Number: 09/447,077

Page 8

Art Unit: 1762



WDM

Examiner
Art Unit 1762



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